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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,277	11/14/2003	Minas Theodore Coroneo	Q78501	7510
23373	7590	02/09/2006	EXAMINER HAND, MELANIE JO	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			ART UNIT 3761	PAPER NUMBER

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/712,277	CORONEO, MINAS THEODORE	
	<b>Examiner</b>	<b>Art Unit</b>	
	Melanie J. Hand	3761	

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 10-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election of group I, claims 1-9, in the reply filed on November 17, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 10-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on November 17, 2005.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph (U.S. Patent No. 4,604,087) in view of Christopher (GB 2,101,891 A).

With respect to **Claim 1**: Joseph teaches an aqueous humor drainage device having drainage tube 2 and drainage body 3. Tube 2 and body 3 are comprised of silicone rubber. Body 3 is a band that is fused or glued to tube 2 and is capable of being folded to a diameter of 1.5 mm or less. The circumference of band 3 is chosen so that it is the correct length to be sutured to sclera 11 of eye 10 at an equatorial position. The second end of tube 2 is located in the anterior chamber 15 through a surgically created opening in the cyclodialysis tract 16. (Col. 3, lines 43-50, 62-65, Col. 4, lines 2-5).

Joseph does not teach that tube 2 is fused to a disc or plate. Christopher teaches an ocular drainage device having a tube 12 and plate 21 wherein the plate has a diameter of 13mm and is capable of being folded to a diameter of 1.5 mm. ('891, Page 1, lines 68,69,90,91) Since prior art devices use a plate that is sutured to the sclera as taught by Joseph (Col. 1, lines 63-67), Examiner asserts that suturing a band performs an equivalent function and is therefore simply an alternate method of forming a drainage device for regulating pressure in the ocular cavity. In the instant case substitution of equivalent methods requires no express motivation, as long as the prior art recognizes equivalency, *In re Fount* 213 USPQ 532 (CCPA 1982); *In re Siebentritt* 152 USPQ 618 (CCPA 1967); *Graver Tank & Mfg. Co. Inc. v. Linde Air Products Co.* 85 USPQ 328 (USSC 1950).

With respect to **Claims 2,3,4,5,9**: Joseph teaches that tube 2 has an inner diameter of 0.3 mm (Col. 3, line 47) and, with the aid of a pressure limiting valve in the form of slits in the tube itself

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(Col. 4, lines 25-30), regulates aqueous flow, therefore the diameter of 0.3 mm is suitable for providing a predetermined resistance to aqueous flow. The pressure limiting valve comprising at least one slit regulates fluid pressure so as to remain in the range of 4-20 mm Hg. (Col. 4, lines 34-37)

With respect to **Claim 6**: Joseph does not teach a plate and therefore does not teach a plate diameter. Christopher teaches an ocular drainage device having a tube 12 and plate 21 wherein the plate has a diameter of 13mm. Since applicant has not assigned a criticality for a plate diameter in the range of 0.5 mm – 6 mm, Examiner is applying the diameter taught by Christopher as prior art rendering claim 6 obvious. Joseph teaches that band 3 has a thickness of 0.75 mm, or 750 microns. However, as stated previously, Joseph does not teach a plate. Since Examiner previously asserts that the band 3 and plate 21 taught by Christopher are interchangeable structures that are both sutured to the sclera and perform a substantially identical function, it would be obvious to one of ordinary skill in the art to modify the device taught by Joseph by substituting a plate as taught by Christopher for said band, with the plate having a thickness equal to that of said band.

With respect to **Claim 7**: Joseph teaches that tube 2 has a length of 24 mm and follows the arc of a circle having a diameter of 30mm. (Col. 3, lines 55-57) As can best be seen, tube 2 follows that arc for about  $\frac{1}{4}$  of the circle, therefore the remaining length of tube that is analogous to the tube of the claimed invention is in the range of 1-4 mm.

With respect to **Claim 8**: Joseph teaches that tube 2 has an inner diameter of 0.3 mm, or 300 microns, and a wall thickness of 0.175 mm, therefore the outer diameter is 0.475 mm or 475 microns. (Col. 3, lines 45-47)

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie J. Hand whose telephone number is 571-272-6464. The examiner can normally be reached on Mon-Thurs 8:00-5:30, alternate Fridays 8:00-4:30.

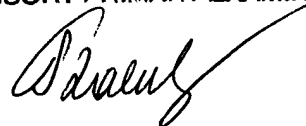
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Melanie J Hand  
Examiner  
Art Unit 3761

MJH

**TATYANA ZALUKAEVA**  
**SUPERVISORY PRIMARY EXAMINER**



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